REMARKS

This is in full and timely response to the Office Action mailed on April 21, 2006.

Reexamination in light of the following remarks is respectfully requested.

Claims 1-2, 5-7 and 9-22 are currently pending in this application, with claims 1, 12, 21 and 22 being independent. *No new matter has been added.*

Rejection under 35 U.S.C. §101

Paragraph 1 of the Office Action indicates a rejection of claim 10 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

This rejection is traversed at least for the following reasons.

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claim 10 has been canceled.

Nevertheless, prior claim 10 is drawn to a program for playing back video data recorded on an information recording medium, said program making a computer execute a process comprising the steps of:

> setting a reproduction speed of said video data depending upon a predetermined acceleration;
>
> reading out said video data from said information recording medium; and
>
> combining a plurality of images of said video data read out in said readout step in accordance with said reproduction speed set in said setting step so as to generate an output image for high-speed playback.

The Office Action contends that, as written, a program for performing steps, unless that program is carried *on a medium*, is not statutory subject matter (Office Action at page 2).

In response to this contention, prior claim 10 is drawn to a program for playing back video data recorded ***on an information recording medium***.

Withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. §112

Paragraph 3 of the Office Action indicates a rejection of claim 10 under 35 U.S.C. §112.

This rejection is traversed at least for the following reasons.

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claim 10 has been canceled.

Withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. §102

Paragraph 5 of the Office Action indicates a rejection of claims 1-3 and 5-11 under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 6,009,236 to Mishima et al. (Mishima).

This rejection is traversed at least for the following reasons.

Claims 1-3 and 5-7 - The features of claim 4 have been wholly incorporated into claim 1 to form amended claim 1. Thus, prior claim 4 is now amended claim 1, rendering the rejection of these claims as moot.

Claims 8-11 - While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claims 8-11 have been canceled, rendering the rejection of these claims as moot.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Rejection under 35 U.S.C. §103

Paragraph 7 of the Office Action indicates a rejection of claim 4 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent No. 6,009,236 to Mishima et al. (Mishima).

This rejection is traversed at least for the following reasons.

At least for the following reasons, if the allowance of claim 1 is not forthcoming at the very least and a new ground of rejection made, then a ***new non-final Office Action*** is respectfully requested.

The features of claim 4 have been wholly incorporated into claim 1 to form amended claim 1. Thus, prior claim 4 is now amended claim 1, rendering the rejection of these claims as moot.

Claim 1 - Claim 1 is drawn to a reproducing device for playing back video data recorded on an information recording medium, comprising:

setting means for setting a reproduction speed of said video data depending upon a predetermined acceleration;

readout means for reading out said video data from said information recording medium; and

generation means for combining a plurality of images of said video data read out by said readout means in accordance with said reproduction speed set by said setting means so as to generate an output image for high-speed playback,

wherein first video data at a high bit rate and second video data at a lower bit rate than that of said first video data for a same material are recorded on said information recording medium; and said readout means reads out said second video data from said information recording medium, and

wherein said first and second video data are intermittently recorded on a physically same track of said information recording medium.

Mishima - The Office Action ***admits*** that Mishima does not specifically disclose intermittently recording first and second video data on a physically same track of the information recording medium (Office Action at page 6).

Nevertheless, the Office Action takes official notice that intermittently recording multiple streams of data, also known as time-division multiplexing, is notoriously well known, commercially available and widely used, allowing a programmer to place several different signals in the same data path (Office Action at page 6).

In response, the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). However, this contention is merely a personal conclusion that is *unsupported by any objective evidence*.

As a rule, "assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference." (Citations omitted). *In re Pardo and Landau*, 214

USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

"Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge." (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

In addition, "it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious" (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) (rejection based upon hindsight is reversed).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner's affidavit upon request. Specifically, "when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 C.F.R. §1.104(d) (2).

*Accordingly, **Applicant hereby requests a reference or an Examiner's affidavit** to support this officially noticed position of obviousness or what is well known.*

Further, note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known **must** be withdrawn. See M.P.E.P. §2144.03.

Also, note that the *failure to provide any objective evidence to support the challenged use of Official Notice constitutes **clear and reversible error**. Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

In addition, this assertion amounts to nothing more than an "obvious-to-try" situation. Specifically, "an 'obvious-to-try' situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, "an invention is 'obvious to try' where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful." *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. "Obvious to try" is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Withdrawal of these rejections and allowance of the claims is respectfully requested.

Newly added claims

Claims 12-22 provide that:

wherein, during said normal playback, said screen displays a frame of said main track data,

wherein, during said high-speed playback, said screen is divided into areas, said areas of said screen partially displaying different frames of said low resolution data.

However, these features and steps are absent from within Mishima.

Allowance of the claims is respectfully requested.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

Extensions of time

Please treat any concurrent or future reply, requiring a petition for an extension of time under 37 C.F.R. §1.136, as incorporating a petition for extension of time for the appropriate length of time.

Fees

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: March 14, 2007

Respectfully submitted,

By_____

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